

REMARKS

I. Status of Claims

Claims 318-336 are currently pending. No claim is amended herein.

II. Rejection under 35 U.S.C. § 112

Claims 335 and 336 have been rejected under 35 U.S.C. § 112, first paragraph as allegedly not enabled. According to the Examiner, the polyamide polymers ethylenediamine/stearyl dimer tallate copolymer and ethylenediamine/stearyl dimer dilinoleate copolymer recited in claims 335 and 336, respectively, are not enabled by the disclosure because “[t]he [s]pecification does not teach the specific monomers included to produce either copolymer. Nothing is disclosed to show the tallate or dilinoleate esters.” Office Action at 4. Applicants respectfully traverse.

The specification clearly discloses Uniclear[®], and that Uniclear[®] polymers are “mixtures of copolymers derived from monomers of (i) C₃₆ diacids and (ii) ethylenediamine.” Instant Application at page 12, ¶ 4. Uniclear[®] is the tradename for ethylenediamine/stearyl dimer tallate copolymer and ethylenediamine/stearyl dimer dilinoleate copolymer, as claimed in claim 335 and 336. See Exhibit 1 of Applicants’ April 19, 2005, Second Substitute Amendment, CTFA pages 657-58. Thus, contrary to the Office’s assertion, the specification *does* teach the specific monomers by alternatively referencing them by their tradename.

The test for enablement is “whether one reasonably skilled in the art could make or use the invention from the disclosure in the patent coupled with information known in the art without undue experimentation.” M.P.E.P. § 2164.01, quoting *United States v. Teletronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988). In the instant case, the Office has

failed to establish that one skilled in the art, armed with the knowledge that Uniclear[®] is ethylenediamine/stearyl dimer tallate copolymer or ethylenediamine/stearyl dimer dilinoleate copolymer, would be unable to make and use the invention as claimed.

Therefore, the instant application's disclosure of Uniclear[®] clearly and adequately enables those skilled in the art to make and use the invention by incorporating at least one structuring polymer chosen from ethylenediamine/stearyl dimer tallate copolymer and ethylenediamine/stearyl dimer dilinoleate copolymer, as claimed in claims 335 and 336. Reconsideration of this ground for rejection is respectfully requested.

III. Obviousness-Type Double Patenting Rejections

Claims 318-336 have been provisionally rejected for obviousness-type double patenting over (1) claims 1-102 of U.S. Application No. 09/733,897; (2) claims 336-367 of U.S. Application No. 09/733,898; (3) claims 1-126 of U.S. Application No. 10/129,377; and (4) claims 1-38 and 41-44 of U.S. Application No. 10/198,931. Additionally, claims 318-334 and 336 have been provisionally rejected for obviousness-type double patenting over claims 1-124 of U.S. Application No. 10/203,254. Finally, claims 318-325, 328-332, and 334 have been rejected for obviousness-type double patenting over claims 1-19 of U.S. Patent No. 6,761,881 to Bara. Applicants respectfully request the Examiner hold the provisional and nonprovisional obviousness-type double patenting rejections in abeyance until patentable subject matter has been indicated in the instant application, at which point Applicants will evaluate whether to file a terminal disclaimer.

IV. Rejection under 35 U.S.C. § 103

Claims 318-334 have been rejected under 35 U.S.C. § 103 as allegedly obvious over U.S. Patent Nos. 6,716,420 to Feng et al. ("Feng"); 6,402,408 to Ferrari ("Ferrari");

5,500,209 to Ross et al. ("Ross"); or 5,783,657 to Pavlin et al. ("Pavlin") taken together with U.S. Patent Nos. 4,699,779 to Palinczar ("Palinczar"); 6,180,123 to Mondet ("Mondet"); or 5,961,998 to Arnaud et al. ("Arnaud").

According to the Office, Feng, Ferrari, Ross, and Pavlin "all teach the conventionality of producing composition[s] comprising a liquid fatty phase which comprises a polyamide polymer and an oil phase as claimed herein." Office Action at 8. The Office further alleges that Feng, Ferrari, Ross, and Pavlin teach the addition of optional ingredients, such as thickening agents and liposoluble polymers. *Id.* at 8-9.

The Office then adds that Palinczar, Mondet, and Arnaud "all teach the conventionality of using alkylated cellulose and gums as suitable thickening agents for compositions that may comprise an oily phase, as claimed herein. These derivatives are notoriously known in the art as thickening agents and coating agents and are liposoluble polymers." *Id.* at 9. From this, the Office apparently concludes that the present claims are obvious because "[t]he constituents all appear to be conventional and known." *Id.* at 10. Applicants respectfully traverse.

A. Feng is not Prior Art

Applicants point out that Feng, one of the cited primary references, is not prior art to the instant application. Feng was filed on October 5, 2001, and issued on April 6, 2004. The instant application, however, was filed on December 12, 2000, almost ten months before Feng's filing date. Therefore, Feng does not qualify as prior art under § 102 and is improperly asserted as a prior art reference in the rejection under § 103. Nonetheless, Applicants address herein the rejection with respect to the other three

primary references (Ferrari, Ross, and Pavlin) and secondary references (Palinczar, Mondet, and Arnaud).

B. The Office has Failed to Show any Motivation to Combine References

To establish a *prima facie* case of obviousness, the Office must demonstrate, among other things, some suggestion or motivation to combine reference teachings. M.P.E.P. § 2143. The threshold for establishing a motivation to combine is high, requiring “clear and particular” evidence. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617, 175 F.3d 994, 999 (Fed. Cir. 1999). As explained by the Federal Circuit, “[o]ur case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” *Id.* at 1617. Importantly, the motivation or suggestion must be found in the prior art references themselves, not in the applicants’ disclosure. See *In re Vaeck*, 20 U.S.P.Q.2d 1438, 947 F.2d 488 (Fed. Cir. 1991).

In the present case, the Office has failed to set forth sufficient evidence of a motivation to combine the references in the manner proposed. Rather, the Office has done nothing more than point to disclosure in the individual references of the individual components of the claims, i.e., at least one polyamide polymer as claimed and at least one oil-soluble polymer chosen from alkyl celluloses and alkylated guar gums. See Office Action, pp. 7-10. Surely this approach cannot satisfy the “clear and particular” evidence of motivation to combine the references, as required by *Dembiczak*, and in fact, appears to be based on hindsight after viewing Applicants’ claims, as prohibited by *Vaeck*.

After a careful study of Ross, Ferrari, and Pavlin, it is readily apparent that none of those cited primary references provide any motivation to combine a polyamide polymer with at least one oil-soluble polymer chosen from alkyl cellulose and alkylated guar gums. Ross, to the contrary, teaches away from adding an additional thickening agent: "Of course, if compositions of the present invention contain gelling/thickening agents other than the polyamide, such as waxes, a white residue would possibly be left on the skin." Ross, col. 9, ll. 15-18. According to Ross, such a white residue is undesirable. See *id.* at ll. 12-15. Thus, one of ordinary skill in the art, when reading Ross, would most certainly not be motivated to add an additional gelling or thickening agent, such as the at least one oil-soluble polymer chosen from alkyl cellulose and alkylated guar gums, as claimed herein.

Likewise, neither Pavlin nor Ferrari provides the requisite motivation to combine at least one oil-soluble polymer chosen from alkyl cellulose and alkylated guar gums with a polyamide polymer. Pavlin merely mentions that "[t]he gel may be combined with ingredients conventionally incorporated into personal care products," (Pavlin, col. 17, ll. 27-29), but does not specifically reference additional thickening agents, much less the at least one oil-soluble polymer chosen from alkyl cellulose and alkylated guar gums as claimed herein. While Ferrari notes that liposoluble polymers may be added to the composition disclosed therein, Ferrari's only reference to an additional thickening agent emphasizes that the thickening agent must be water-soluble, and not oil-soluble as claimed herein: "The composition of the present invention may further comprise at least one suitable additive commonly used in the field concerned chosen from water optionally thickened or gelled with an **aqueous-phase thickener or gelling agent**"

Ferrari, col. 7, ll. 11-14 (emphasis added). Thus, the Office has failed to point to any suggestion or motivation to combine at least one oil-soluble polymer chosen from alkyl cellulose and alkylated guar gums with the polyamide polymer disclosed in Ross, Pavlin, or Ferrari.

Moreover, none of Palinczar, Mondet, or Arnaud, which all disclose either an alkylated guar gum or an alkyl cellulose, teach or suggest combining those secondary ingredients with a polyamide polymer. Thus, the Office has failed to point to any "clear and particular" evidence of motivation to combine the references, as required by *Dembiczak*.

As the Office is aware, even though individual components of the invention may be found separately in the references of record, these separate disclosures do not defeat the patentability of the composition as a whole. Merely identifying each of the claimed elements in the prior art is not sufficient to establish a *prima facie* case of obviousness. The Federal Circuit has held that "[m]ost if not all inventions arise from a combination of old elements However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention." *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1316, 217 F.3d 1365, 1370 (Fed. Cir. 2000) (citations omitted). It is not sufficient to merely "find every element of a claimed invention in the prior art" and for the Office to "use the claimed invention itself as a blue print for piecing together elements Such an approach would be an illogical and inappropriate process by which to determine patentability." *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (citations and quotations omitted).

Thus, the Office's statement that the claims are obvious because "[t]he constituents all appear to be conventional and known" is clearly in contravention of current law.

As the Office has not established any suggestion or motivation to combine the references, no *prima facie* case of obviousness has been established, and therefore, the rejection is legally improper and should be withdrawn.

V. Copending Applications

In the Amendments filed on May 5, 2004, and February 9, 2005, in this case, Applicants noted in Table 2 information regarding a total of 41 copending applications, including the present application, and submitted copies of the pending claims as of that date for every case identified in Table 2. In the following Table 2, Applicants have noted two additional applications that have been filed, and enclose herewith in Exhibit 1 a copy of the copending claims for the additional cases. Applicants also direct the Office's attention to U.S. Patent No. 6,761,881 B2, which issued to Isabelle Bara on July 13, 2004, and is assigned to L'Oreal. This patent is also related to the co-pending applications identified in Table 2 below, and a copy of its copending claims is also attached with Exhibit 1.

Furthermore, Applicants submit herewith also in Exhibit 1 copies of the currently pending claims from the following copending applications, which claims have been amended since February 9, 2005: 09/685,577; 09/733,896; 10/787,440; 10/203,254; 09/749,036; 10/413,217; 10/699,780; 10/046,568; 10/047,987; 10/312,083; 10/746,612; 10/203,374; 09/733,898; 10/203,375; and 10/182,830. The submission is intended to allow the Office to make its own independent evaluation of whether any issue exists regarding statutory or obviousness-type double patenting.

Table 2

Attorney Docket No.	U.S. Patent Application No.	U.S. Filing Date/ 371 (c) Date	Inventors	Title	Assignment Recorded (Reel, Frame, Date)	Publication, Date
05725. 0816- 03000	11/212,811	August 29, 2005	Véronique FERRARI, Richard KOLOD- ZIEJ, Carlos O. PINZON, and Paul THAU	COMPOSITION COMPRISING A POLYAMIDE POLYMER AND AT LEAST ONE INERT FILLER	Reel 014055, Frame 0428 on March 24, 2003	Not yet published
06028. 0047- 00000	10/494,864	May 7, 2004	Didier CANDAU and Christèle GOMBERT	COMPOSITION CONTAINING AN AMINO ACID N-ACYLATED ESTER AND A POLYAMIDE- STRUCTURED UV FILTER	Reel 016044, Frame 0874, on November 23, 2004	U.S. Published Application No. US 2005/ 0065251 A1 Dated: March 24, 2005

VI. Conclusion

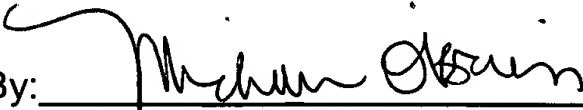
In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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